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KILPATRICK STOCKTON LLP  
607 14TH STREET, N.W.  
SUITE 900  
WASHINGTON, DC 20005

EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2171

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/820,659

Applicant(s)  
Igbal Talib et al.

Examiner  
T. Chen

Art Unit  
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 30, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

1. Claims 1-45 are presented for examination.

#### ***Claim Objections***

2. Claim 12 is objected to because of the following informalities: the claim dependency is incorrect. In the interest of compact prosecution, it is assumed that claim 12 is dependent on claim 11. Appropriate correction is required.

#### ***Specification***

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification. Also, It is noted that the present specification does not contain line numbers. For ease of reference by both Examiner and Applicant all future correspondence should include the recommended line numbering.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 522 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937,

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214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-45, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as claiming the same invention of the copending application Serial No(s). -- 09/820,613, 09/820,660, 09/820,661, 09/820,662. The mapping of the similar claims is as following:

<u>'613</u>	<u>'659</u>	<u>'660</u>	<u>'661</u>	<u>'662</u>
1-9	1-9	1-9	1-9	1-9
10	10			
11-21	11-21	11-21	11-21	11
22	22			
23-33	23-33	23-33	23-33	21-29
34	34			
35-42	35-42	35-42	35-42	31-36
44-45	44-45	44-45	44-45	

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5. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter recited in these five applications are nearly verbatim reproductions of what is claimed in the current application. A detail comparison is given in the following paragraphs:

6. Regarding claims 1-45 of the instant '613 application, the '659 application claims 1-45, respectively, are drawn to the same invention, except that instead of claiming "an archive of documents" as by the current application, the '659 application claimed "an information directory". The examiner takes official notice that it is well known in the database art to arrange the archived document via an information directory for later reference. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the '659 application invention by applying the well known information directory mechanism on an archived document. Because by doing so, the system is allowed to refer to the stored document with the most common and handy directory structures as desired.

7. Based on the summary table above, the claims of the instant '659 application and the '660 application, respectively, are drawn to the same invention, except that instead of claiming "an archive of documents" as by the current application, the '660 application claimed "a collection of employment and job data". The examiner takes official notice that it is well known in the database art to archive a collection of employment and job data in a document structure to

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facilitate the data searching. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the '659 application invention by storing the collected employment and job data in a document. Because by doing so, the system would provide the ability for end user to search for employment information with ease.

8. Based on the summary table above, the claims of the instant '659 application and the '661 application, respectively, are drawn to the same invention, except that instead of claiming "an archive of documents" as cited by the current application, the '661 application claimed "an electronic product catalog". The examiner takes official notice that it is well known in the database art to organize archived documents with the electronic product catalog for on-line accessing. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the '659 application invention using this well known electronic catalog technique to group data. Because by doing so, the system end user is allowed to access well organized cataloging data as needed.

9. Based on the summary table above, the claims of the instant '659 application and the '662 application, respectively, are drawn to the same invention, except that instead of claiming "an archive of documents" as cited by the current application, the '662 application claimed "a bioinformatics data collection". The examiner takes official notice that it is well known in the database art to collect bioinformatics data to shift business from laboratory bench to computer

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desktop. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the '659 application invention by allowing the collection of bioinformatics data, since by doing so, the system end user is allowed to process bioinformatics data via computer desktop.

10. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. As to claim 2, the use of the phrase "can be" renders the claimed feature indefinite, since these terms lead to the argument of anything actually occurs or results.

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***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wical (U.S. Patent No. 5,940,821) and in view of Van Huben et al. (U.S. Patent No. 6,484,177).

16. As to claims 1, 13, 25 and 37, Wical discloses a system with method, means and computer program product for searching a data collection, comprising:

- \* an organizer [i.e., the search and retrieval unit (100), Fig. 1] configured to receive search requests, the organizer comprising: a data collection having at least two entries [col. 2, lines 40-65; col. 5, lines 49-52];

- \* wherein the data collection is organized into at least two taxonomies [e.g., see Fig 8A, the social sciences is organized into History, Anthropology, and Linguistics taxonomies]; wherein each of the at least two taxonomies is associated with at least two categories [e.g., see Fig. 8A, the History taxonomies is associated with the Ancient History & Ancient Rome categories; the Anthropology taxonomies is associated with Customs and Practices, Kinship and Marriage, Peoples, & Races of Peoples, etc.; col. 2, lines 40-65; Fig(s). 3-4, 8A-C; 9AC];



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\* wherein the entries correspond to at least one of the at least two taxonomies and also correspond to at least one of the at least two categories [Fig(s). 3-4, 8A-C, 9AC];

\* a search engine [e.g. the Query Processing unit (175), Fig. 1] in communication with the electronic product catalog [e.g., the Knowledge Catalog unit (150), Fig. 1], wherein the search engine is configured to search based on the at least two taxonomies and based on the at least two categories [col. 7, lines 61-67; col. 25, lines 10-60];

\* wherein the search engine, returns, in response to a search request [e.g., the search query "Internet", col. 25, lines 10-11 ] identifying at least a first taxonomy of the at least two taxonomies [e.g., see Fig. 10A, wherein, the first "Computer Networking" taxonomy with 15 hits is identified from the other 4 categories, in response to the "internet" query], a list of the categories associated with the at least first identified taxonomies, along with the number of entries [e.g., the statement -- "Found 15 Documents and 5 categories, Fig. 10A] associated with each of the categories associated with the at least first identified taxonomies [col. 25, lines 27-45; Fig(s). 10A-C].

17. The difference between Wical and the invention of claims 1, 13, 25 and 37 is that: these claims relate to "an archive of documents", whereas Wical relates to a data collection including "a compilation of information from any sources" [col. 5, lines 54-55] and does not explicitly indicate that the data collection is "an archive of documents " as claimed.

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18. However, archiving a data collection into the directory of a system is well known in the art, as exemplified by Van Huben et al. (hereinafter referred as Van Huben) [Title, Abstract, Fig(s). 1-4B]. Consider this, it would have been obvious to one of ordinary skilled in the art, at the time of the invention, to apply this well known technique into Wical's data query system , because as indicated by Van Huben, the conventional data management system "fails to propose a common system-independent paradigm that can be applied to any type of data ranging from a simple file residing in a file system, to an object under the control of a directory service, all the way to information residing in a traditional database." Thus, By combining Van Huben's invention into Wical's system would allow the combined system not only classifying data via common means, but also mandating any relationship between the directory service, file system and database.

19. As to claims 2, 14, 26 and 38, except the features disclosed above, Van Huben further teaches the system have the following features:

- \* the returned list of categories associated with the first taxonomy, along with the number of entries associated with each of the categories associated with the identified taxonomy will be further searched with regard to at least a second taxonomy of the at least two taxonomies [e.g., see Fig. 5]. Whereby, the search engine returns, in response to a search request identifying the at least second taxonomies of the at least two taxonomies, a list of the categories associated with

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both identified taxonomies, along with the number of entries associated with each of the categories associated with the second taxonomies [e.g. see col. 15, line 66 - col. 16, line 16 ].

20. As to claims 3, 15, 27 and 39, except the features disclosed above, Wical further teaches the system have the following features:

wherein the search engine, having returned, in response to a search request identifying at least a first taxonomy of the at least two taxonomies, a list of the categories associated with the identified taxonomies, along with the number of entries associated with each of the categories associated with the identified taxonomies, will provide only those categories with a non-zero number of entries associated with the identified taxonomies and will further return sub-categories both associated with the category and having a non-zero number of entries associated with the sub-category [col. 25 lines 10-45 and Figs 10 B-C].

21. As to claims 4, 16, 28 and 40, except the features disclosed above, Wical further teaches the system have the following features:

wherein the search engine, having further returned sub-categories both associated with the category and having a non-zero number of entries associated with the sub-category, will, in response to a search request identifying at least a second taxonomy of the at least two taxonomies, provide a list of the categories with a non-zero number of entries associated with the at least second identified taxonomies, along with the number of entries associated with each

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of the categories associated with the at least second identified taxonomies [col. 25 lines 10-45 and Figs. 10A-C].

22. As to claims 5, 17, 29 and 41, except the features disclosed above, Wical further teaches the system have the following features:

wherein the search engine, having returned, in response to a search request identifying at least a first taxonomy of the at least two taxonomies, a list of the categories associated with the identified taxonomies, along with the number of entries associated with each of the categories associated with the identified taxonomies, will, in response to a string query, provide those entries which both contain the string and are associated with the identified taxonomies [col. 25 lines 10-45 and Figs. 10A-C].

23. As to claims 6, 18, 30 and 42, except the features disclosed above, Wical further teaches the system have the following features: wherein the string is one member of the group consisting of text, image, and graphic [ Figs. 11 A-B].

24. As to claims 7, 19 and 31, except the features disclosed above, Wical further teaches the system have the following features: wherein the system comprises a network of computers [col. 5 lines 55-60].

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25. As to claims 8, 20 and 32, except the features disclosed above, Wical further teaches the system have the following features: the system comprises a single computer [Fig. 14].

26. As to claims 9, 21 and 33, except the features disclosed above, Wical further teaches the system have the following features: the system further comprises a cache which stores the returned results of the search engine for rapid retrieval [col. 31 lines 65-67].

27. As to claims 10, 22, 34 and 43, except the features disclosed above, Van Huben further teaches the system have the following features: at least one taxonomy of the at least two taxonomies is selected from the group consisting of products, services, location, industry, business type, etc. [e.g., see Fig. 5].

28. As to claims 11, 23, 35 and 44, except the features disclosed above, Wical further teaches the system have the following features: the search engine additionally returns an advertising entry [e.g., the Resume Maker, Fig. 8].

29. As to claims 12, 24, 36 and 45, except the features disclosed above, Wical further teaches the system have the following features: the advertising entry is at least one member selected from the group consisting of a banner advertisement and a search-visible storefront [e.g., 14, 138, Fig. 8].

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*Conclusion*

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Seihamer et al. (U.S. Patent No. 6,023,659) which disclosed a data query system with database employing protein function hierarchies for viewing bimolecular sequence data ; Lowry (U.S. Patent No. 5,953,724) which disclosed a system with global database library for hierarchical graphical listing computer software; Brown et al. (U.S. Patent No. 5,875,466) which disclosed a system and method for hierarchically grouping and ranking a set of objects in a query context based on one or more relationships.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone number for this group are:

(703) 746-7238 (After Final Communication);

(703) 746-7239 (Official Communications); and


(703) 746-7240 (For Status Inquiries, Draft Communication).

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33. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

June 25, 2003

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER